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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,750	10/10/2001	Robin Bek	9222.16632-CIP CON	8777

7590                    09/30/2002

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/974,750	Applicant(s)	BEK ET AL.
Examiner	Michael Peffley	Art Unit	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 10 October 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

***Inventorship***

The examiner is unable to determine the correct inventorship of the instant application. This application has been filed as a continuation of US Serial No. 09/495,390 which listed as inventors Robin Bek, John Gaiser and Jay Qin. Applicant's Transmittal Letter of October 10, 2001 states that inventors Robin Bek and Jay Qin are to be deleted, and inventors David Utley and Stuart D. Edwards are to be added (page 3 of the supplemental papers). However, the declaration filed May 9, 2002 lists Robin Bek, John Gaiser, Jay Qin and David S. Utley as the inventors. Also, applicant has filed no petition under 37 CFR 1.48(a) to change inventorship. Applicant is required to clarify the inventive entity of this application and file the appropriate petitions if there is a change of inventorship from the parent application.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 is directed solely to printed subject matter, which is non-statutory subject matter. In particular, claim 9 merely sets forth a set of instructions for the use of the device, which set of instructions constitute printed subject matter which is not functionally associated with the operation of the device.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is meant by a "processing function" in claim 11. There appears to be no particular structure being claimed which is supportive of the "processing function". It is not clear if such a "processing function" is an intended use or inherent capability of the controller, or if there is additional structure which provides the "processing function".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al ('169) in view of the teaching of Harman et al ('718).

Panescu et al disclose an electrosurgical system for applying RF energy to tissue. The system includes a device for treating tissue (10), and a code on the device to identify the device. The code may be stored on the device in a number of ways including ROM chips, RAM chips, or other memory devices (col. 26, lines 63-67). The system further includes a reader and controller (108) for reading the code and controlling operation of the generator accordingly. The reader (178) may compare the

code to a table of values (180) to identify the operational characteristics of the device.

Panescu et al fail to specifically disclose a key card as the code storage means, and fail to disclose certain processing functions as set forth in claims 12-15.

With regard to the use of a key card as the storage medium, Harman et al disclose a medical device (i.e. laser device) which includes a key card (70) which stores an identification code for identifying the medical device. In as much as Panescu et al disclose several different types of storage mediums usable to store the identification code, it is deemed an obvious modification to employ a key card as an alternative identification medium. It is generally known to provide sterile packaging for medical devices, and the Panescu et al device(s) would inherently, or at least obviously, be provided with such a packaging.

Concerning the processing functions, it is noted that Panescu et al provide means to process the codes of devices in several ways. The controller can compare codes in a table and can also control the operation of the generator in response to a detected code (columns 25 and 26). Panescu et al does not specifically disclose the function of registering a code which is not located on the table. The examiner maintains that it is generally known in the art to provide operators of such memory units with means to input desired information. The codes (180) stored by the interpreter (178) were manually entered by a user or operator at some point in time. To provide the interpreter with a means to enable the user to enter new codes into the table is deemed an obvious improvement. Those of ordinary skill in the processing and memory arts are fully capable of providing such an input function in a processor.

In conclusion, to have provided the Panescu et al system with a key card as the code storing medium for providing an identification code to a surgical device is deemed an obvious design consideration for one of ordinary skill in the art in view of the teaching of Harman et al. To have further provided the Panescu et al processing system with means to update codes through an input means is deemed an obvious consideration for one of ordinary skill in the processing art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meinema ('615) and Jackson et al ('780) disclose various means to provide an identification code to a medical instrument.

This is a continuation of applicant's earlier Application No. 09/495,390. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

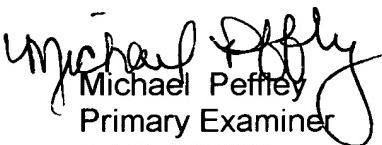
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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
September 27, 2002